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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/069,377	02/25/2002	Olivier Parrault	BONN -071	7967
7590	10/03/2003		EXAMINER	
James C Lydon 100 Daingerfield Road Suite 100 Alexandria, VA 22314			LEE, DIANE I	
			ART UNIT	PAPER NUMBER
			2876	
DATE MAILED: 10/03/2003				

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/069,377

Applicant(s)

PARRAULT OLIVIER

Examiner

D. I. Lee

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 25 February 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 13-24 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 13-24 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 2.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

1. Receipt is acknowledged of the Preliminary Amendment filed 25 February 2002. Claims 1-12 have been canceled and claims 13-24 have been newly added.

Priority

2. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

Specification

3. **The abstract of the disclosure is objected to because of the following(s):**
 - (a) Line 4: "display means" should be changed to --display--;
 - (b) Line 4: "a means" should be changed to --a receiver--; and
 - (c) Line 6: "receiving means" should be changed to --receiver--.

Correction is required. See MPEP § 608.01(b).

Claim Objections

4. Claims 15 and 22 are objected to because of the following informalities:
 - (a) Re claim 15, line 2: **"transmitted" should be changed to --received--** for the energy and the information generated by the reader is received by the device rather than transmitted; and
 - (b) Re claim 22, line 3: **"the same plate" should be changed to --a same plate--** for same plate lacks antecedent basis.

Appropriate correction is required.

Claim Rejections - 35 USC § 112

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. **Claims 13-24 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.**

(a) **Re claim 13:** Claim recites a peripheral display device having a flat coil as a receiving means for receiving energy and information which plays the role of the secondary of a transformer, and the primary of which consists of the antenna of said portable object. Claim further recites the latter receives energy and information from a reader of said portable object by the electromagnetic coupling.

It is not clear which device (e.g., among a flat coil of the display device and an antenna of portable object) applicant is referring as the latter receives energy and information from a reader. As best understood by the examiner, the latter device that receives energy and information from a reader of said portable object by the electromagnetic coupling is referring the flat coil.

(b) **Re claim 13:** In line 7, claim calls for the secondary transformer without reciting a first or primary transformer prior to the recitation of the secondary transformer. Although, the primary transformer is recited later in the claim, the examiner respectfully requests applicant to define or recite the primary transformer prior to the secondary transformer.

(c) **Re claim 17:** *“a persistent display, such that the information remains displayed on a said display means for a time period greater than the average period between two transaction”* is vague and indefinite for applicant has not given the time period of one transaction. Thus, the average period between undefined two transaction time periods is unknown. Please clarify the claim language in next communication. For examining purpose, claimed persistent display has been translated as any display that displays the information for a predetermined time.

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Therefore, claims 13, 17 and claims which depend therefrom, i.e., claims 14-16, 18-24 are vague and indefinite.

Claim Rejections - 35 USC § 102

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

8. **Claims 13-16, 19-20, and 22 are rejected under 35 U.S.C. 102(e) as being anticipated by Hook et al. [US 2001/0054005 A1-referred as Hook].**

Re claims 13-15: Hook teaches a plurality of embodiments of the peripheral display device (an electronic display of information) for contactless portable objects (shelf tag 10) enabling information associated with the use of said portable object to be displayed, comprising at least one chip 54 (see par. 54, 71, and fig. 71);

a display means (a liquid crystal display (LCD) 26, 200); and

an inductive coil 352 as a means for receiving energy and said information (i.e., the energy and the information received by the inductive coil 352 are from the external device 160 when the portable object is coupled with the external device, therefore, the information is not connected by ohmic contact to said portable object 10) (see par. 53, 82), said receiving means being a flat coil (not explicitly shown) which plays the role of the secondary transformer, the primary of which consists of the antenna of said portable object (see par. 86), when the latter receives energy and information from a reader 160 of said portable object by electromagnetic coupling (i.e., RF coupling).

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Re claim 16: wherein said information transmitted by the antenna (see figure 16, 19) of said portable object is generated by the chip 278 of said portable object (see par. 71 and figure 16);

Re claims 19-20: the device further includes a notoriously old and well-known capacity as an energy storage means (see par. 83).

Re claim 22: Hook shows that the flat coil is being in a same plate as the antenna of the portable object (see fig. 16).

Claim Rejections - 35 USC § 103

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. **Claims 23-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hook.**

The teachings of Hook have been discussed above.

Re claim 23: Although Hook shows that the flat coil is being in a same plate as the antenna of the portable object, he does not explicitly show that the device can be separated from the portable object.

Hook shown in figure 3 that the device is stacked to the of the portable object, therefore, an artisan of ordinary skill in the art would have recognized that the device **can be** separated from the portable object. Furthermore, since it has been held that constructing a formerly integral structure in various elements involves only routine skill in the art. *Nerwin b. Erlichman*, 168 USPQ 177, 179.

Re claim 24: Hook teaches that the coil 352 will be excited and an electric current through the coil will be induced. The display device having a display driver 232, which includes a resistor ladder 236

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and a decoder logic unit 238. The resistor ladder 236 generates each of the time varying signals 224, 226, 228 and 230.

Hook does not teach the device is capable of sending a response to said portable object reader by retromodulation, via said flat coil, coupled to the antenna of said portable object.

However, the applicant admits that the value of the retromodulation subcarrier frequency is equal to 847 kilohertz (kHz), which is a standard currently used.

Thus, it would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to modify the device of Hook to handle different known frequency, so as to communicate at a standard currently used frequency. Such modification would have provided the device that is configurable to a standard currently used.

11. **Claims 17-18 and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hook in view of Freeman [WO 99/38117, cited by the Applicant].** The teachings of Hook have been discussed above.

Hook does not teach a persistent display means provided with a long-persistence screen feature or a bistable liquid crystal display.

Freeman discloses a chip card 100 having a bistable type of liquid crystal display requiring no power to continuously display an image (see the abstract).

It would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to incorporate the bistable liquid crystal display, as taught by Freeman, in the teaching of Hook in order to provide a tag that will maintain a display image on the screen when the tag is not coupled with the reader. Such modification would have provided a longer time period of viewing the display information, thus accommodating a slow reader.

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Double Patenting

12. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

13. **Claims 13-24 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 15-28 of copending Application No. 10/069,378.**

Although the conflicting claims are not identical, they are not patentably distinct from each other because the scope of the invention of the instant application and the claimed invention of 10/069,378 are almost identical and claimed limitations of the instant application obviously encompass the claimed invention of 10/069,378 and differ only in terminology. Accordingly, they are not patentably distinct from each other. Therefore, in respect to above discussion, it would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to use the teachings of 10/069,378 as a general teachings for the claim invention of the instant application.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Conclusion

14. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

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Nitta [US 4,851,654], Takemoto et al. [US 2003/0109303 A1], Ohta et al. [US 4,818,853], Kamei [US 6,223,990 B1], and Emori et al. [US 6,378,774 B1] disclose a portable contactless object having a display device.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to D. I. Lee whose telephone number is 703-306-3427. The examiner can normally be reached on Monday through Thursday from 5:30 AM to 4:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael G. Lee can be reached on 703-305-3503. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0956.



D. I. Lee
Primary Examiner
Art Unit 2876

D. L.